

## REMARKS

Reconsideration of the above-referenced application is respectfully requested in view of the above amendments and these remarks. Claims 1, 3-9, 11-15 and 16-20 are currently pending.

According to the Office Action, claims 1, 3-9, 11-15 and 17-20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No.6,665,521 B1 to Gorday in view of United States patent No. 6,385,461 B1 to Raith. For a rejection under Section 103(a), it is incumbent upon the Examiner to prove a *prima facie* case of obviousness (MPEP 2142). To establish a *prima facie* case three basic criteria must be met. First, the prior art reference must teach or suggest all the claim limitations. Second, there must be a reasonable expectation of success. Finally, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Applicants have carefully reviewed the cited references and respectfully traverse the rejection because there is no suggestion or motivation contained in the references to combine them.

Before obviousness may be established, the Office Action must show specifically the principle, known to one of ordinary skill that suggests the claimed combination. *In re Lee*, 277 F.3d 1338, 1343 (Fed. Cir. 2002). In other words, the Examiner must explain the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention. *Id.* The factual question of motivation is material to patentability and cannot be resolved based on subjective belief and unknown authority. *Id.* at 1344. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577 (Fed. Cir. 1984). The critical inquiry is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Fromson v. Advance Offset Plate*, 755 F.2d 1549, 1556 (Fed. Cir. 1985). The Office Action fails to show

either a suggestion in the art or a compelling motivation based on sound scientific principles to combine the references and therefore the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn. Applicants respectfully submit that there is no suggestion to combine the references, and if they could be properly combined, do not lead to the Applicants' invention.

Gorday was described in Applicants' Amendment filed November 15, 2006. In sum, Gorday is directed to pagers and a paging system where the individual wireless devices do not participate in group calls with one another. In addition, the pages that are cited in the Office Action are the actual communications to which Gorday's disclosure is directed. These pages are not used to establish group communications between the mobile units as required by the present claims.

Raith is directed to group call services which uses broadcast or point-to-point radiocommunication resources to provide information to a mobile station user. First indications of existing group calls are transmitted to mobile stations. Then, users of mobile stations are alerted to the existence of relevant group calls, i.e., those calls in which they are eligible to participate. The portions of Raith cited to in the Office Action refer to the group calls that are a part of the Raith's disclosure, but these references do not suggest anything about underlay or overlay cells and establishing group calls by listening for pages to set up the group calls. In particular, column 10, line 60 to column 11, line 6 merely discloses group calls are established using a paging technique that may include using a user group identifier (UGID), which may be transmitted using a broadcast resource. Likewise, column 4, line 49 to column 5, line 27 disclose the use of a broadcast channel to inform users of group calls, that a UGID is used, and that flags inform a mobile stations whether has been any changes in the broadcast information.

Accordingly, it is taught that mobile stations conserve battery power. The fact that Raith discloses broadcast channels does not teach or suggest the arrangement of overlay and underlay cells regardless of the different messages being sent over those cells.

Applicants respectfully submit that Raith discloses nothing more than group calls and broadcast messages.

There is nothing in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination cited by the Examiner. The paging system

of Gorday does not hit or suggest a combination with the broadcast messages and UGIDs of Raith taught by Raith. The Examiner alleges that Gorday and Raith are analogous arts and in the same field of endeavor. Applicants respectfully disagree. Gorday discloses paging systems, which is a particular branch of wireless communications, and Raith discloses group calls, which is very different type of communications. As paging systems do not pertain to group calls as they are not relevant, there is nothing within Gorday to look to a reference like Raith for further teachings regarding group calls. In addition Raith's group calls do not require overlay and underlay cells. Applicants assert that considering the differences between Gorday and Raith that there is no motivation in either to combine the two and any assertion to the contrary is impermissible hindsight reconstruction based on Applicant's own teachings.

In view of the foregoing, Applicants respectfully submit that the combination of Gorday and Raith does not disclose, teach or otherwise suggest the present invention as found in independent claims 1, 9, 15 and 20. In particular, Gorday and Raith do not disclose the combination of the overlay and underlay cells and group call between the mobile unit and that the group calls are established using the claimed pages. Accordingly, it is respectfully submitted that independent claims 1, 9, 15 and 20 are patentable over Gorday and Raith. As claims 3-8, 11-14 and 15-19 depend upon and include the limitations of claims 1, 9 and 15, respectively, Applicants submit that these dependent claims are not obvious over the combination for the same reasons. Applicants therefore request that the rejection under Section 103(a) be withdrawn.

As the Applicants have overcome all substantive rejections and objections given by the Examiner and have complied with all requests properly presented by the Examiner, the Applicants contend that this Amendment, with the above discussion, overcomes the Examiner's objections to and rejections of the pending claims. Therefore, the Applicants respectfully solicit allowance of the application. If the Examiner is of the opinion that any issues regarding the status of the claims remain after this response, the Examiner is invited to contact the undersigned representative to expedite resolution of the matter.

Serial No. 10/747,964  
Wilson et al  
Case No. CE08893I

Please charge any fees associated herewith, including extension of time fees, to  
**50-2117.**

Respectfully submitted,  
Wilson, Timothy J. et al.

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